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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/982,035	10/17/2001	Masakatsu Masaki	5000-4963	7520

27123 7590 05/11/2006

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EXAMINER

KOCH, GEORGE R

ART UNIT	PAPER NUMBER
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1734

DATE MAILED: 05/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/982,035

Applicant(s)

MASAKI ET AL.

Examiner

George R. Koch III

Art Unit

1734

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 19 April 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

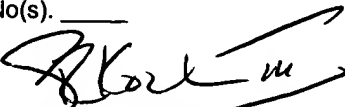
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: 41.
Claim(s) objected to: _____.
Claim(s) rejected: 1,6-10,12,13,25,44 and 47-56.
Claim(s) withdrawn from consideration: 19-24 and 35-40.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.


George R. Koch III
Primary Examiner
Art Unit: 1734

Continuation of 11. does NOT place the application in condition for allowance because: Applicants arguments are unpersuasive. Applicant argues that Krueger does not disclose, teach or suggest a supporting device having "a slidably supported structure, wherein the slidably supported structure is in exclusively slidable engagement with the supporting device". Applicant argues this point by arguing that there is no structure in Krueger that is analogous to applicant's disclosed slidably supported structure - as exemplified by items 10 and 23 of applicant's drawings (best seen in applicant's figure 3).

However, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., item 23 and its subelements as best shown in Figure 3) are not fully recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Rather, claims must be given their broadest reasonable interpretation. *MPEP* 2111; *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000).

Furthermore, Krueger clearly shows some structures analogous to the slidably support structure. For example, Figure 11, as cited in the prior office action, shows that the applicator (item 49) can move (i.e., slide) in two directions. Column 10, also cited in the prior action, describes these elements.. Furthermore, to support this, Krueger explicitly states in other locations that this movement is used to effect relative movement between the applicator and the object (see column 6, lines 21-35). As further laid out, this structure includes a variety of cylinders for effecting a light touch (column 5, lines 1-3). Columns 5-11 generally lay out the structure of this mechanism. Applicant tries to characterize these cylinders as not permitting freely slidable movement., however this is unpersuasive because the cylinder is capable of functioning in an identical manner as the driving cylinder (item 25) of applicants own invention (see pages 11-12 of the application). For example, the cylinder can be used to return the applicator to the start position by simply providing a neutral biasing force, which allows the applicator to slide back and forth in response to movement of the processing device.

Therefore, Krueger discloses structure between the processing head and the supporting device which reads upon the limitations for a slidably support structure.

Secondly, applicant's arguments with respect to the workpiece, and its concave portion, are spurious and without merit. The material or article worked upon does not limit apparatus claims. *MPEP* 2115. "Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim." *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969). Furthermore, "[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims." *In re Young*, 75 F.2d 996, 25 USPQ 69 (CCPA 1935) (as restated in *In re Otto*, 312 F.2d 937, 136 USPQ 458, 459 (CCPA 1963)). Similarly, the structure of the article worked upon, a concave automobile portion, is irrelevant to the structure of the apparatus doing the work, so long as the apparatus is capable of application. In this case, the applicator of Krueger is capable of applying fluid to a wide range of substrates (and see column 1, lines 8-10, which discloses this capability). The applicator tip is a ideally a felt (misspelled, probably felt) or foam pad, which is clearly capable of applying any time of fluid to a concave surface.

With respect to the arguments applicant makes against the 35 USC 103(a) rejections, these arguments essentially repeat the arguments above.